

REMARKS

Claims 1-17 are in this application.

The Examiner has rejected claims 1-17 as being obvious over the combination of Jansen (US patent 6,243,450) in view of Porter (US patent 5,740,161). This is respectfully traversed.

The Examiner admits that Jansen does not explicitly teach a video camera, which inputs video images, connected to the computer, said computer being programmed to use said video camera to provide video-conference service to the user. The Examiner then relies on Porter. However, the Examiner's reliance on Porter is misplaced and the Examiner has not set out a *prima facie* showing of obviousness. In the Patent Office's Examination Guidelines for Determining Obviousness Under 35 USC 103, the Patent Office directs Examiners to be mindful that:

The Supreme Court in *KSR International Co. v. Teleflex Inc.* noted that the analysis supporting a rejection under 35 USC 103 should be made explicit. The Court quoting *In re Kahn* stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ 1385,1396 (2007).

The Examiner has not provided an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. In fact, the Examiner is relying on impermissible hindsight. According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the

standard with which obviousness is determined.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See *Panduit Corp. V. Dennison Manufacturing Co.* 227 USPQ 337, 343 (Fed. Cir. 1985):

It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. *Vandenberg v. Dairy Equipment*, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing *In re Spinnoble*, 160 U.S.P.Q. 237 (CCPA 1969). In *Uniroyal, Rudkin-Wiley*, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Porter discloses a system for synchronized viewing in a controlled conferencing environment. There is no suggestion in Jansen that there is a need for a video camera for video conferencing in a kiosk for pay-per-use services for Web-Based Public Access Services. In fact, given the disclosure in Jansen that the terminals are intended for use in public locations

(see column 1, lines 28-53) and Porter's disclosure of videoconferencing in a **controlled (e.g. private)** environment, it would not be obvious to include video cameras in public access portals. In fact, given certain privacy concerns about carrying out private business in public places, it would not be obvious to add video cameras to a portal that can be used in a public location.

Therefore, the invention of claims 1-17 is not obvious and it is respectfully requested that this rejection be withdrawn.

Respectfully submitted,



JANET L. CORD

LADAS & PARRY LLP

26 WEST 61 STREET

NEW YORK, NY 10023

(212) 708-1935

REG. NO: 33,778